

Remarks

A. Claims in the Case

Claims 1-27, 30-60, 62-101, 104-145 are pending. Claims 1, 40, 53, 71, 113, and 144 have been amended.

B. Examiner Interview

An interview was conducted on December 5, 2006 among the Examiner, the undersigned, and Chris Thompson, a colleague of the undersigned. The rejections of at least claims 1, 25-27, 30, 31 40, 53, 65, 71, 113, and 144 under 35 U.S.C. § 102 and/or 35 U.S.C. § 103 were discussed. Applicant sincerely appreciates the Examiner's taking the time to discuss the case.

C. 35 U.S.C. 112, Second Paragraph

Claims 113-143 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner takes the position that the phrase "the maximum value" lacks sufficient antecedent basis. Applicant has amended claim 113 for clarification. Applicant respectfully requests removal of the rejections under 35 U.S.C. § 112, second paragraph.

D. The Claims Are Not Anticipated by Guinta et al. Under 35 U.S.C. 102(b)

Claim 71 was rejected as being anticipated by U.S. Patent No. 5,737,494 to Guinta et al. (hereinafter "Guinta"). Applicant respectfully disagrees with these rejections.

The standard for "anticipation" is one of fairly strict identity. A claim can only be anticipated if each and every element set forth in the claims is found to be either expressly or

inherently described in the cited art. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 728, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP § 2131.

Amended claim 71 describes a combination of features including:

obtaining information about the organization to be assessed, wherein the information comprises information regarding potential assessors, wherein obtaining the information regarding potential assessors comprises the computer system generating at least one question configured to identify at least one person with knowledge pertinent to an assessment;

the computer system preparing at least one question regarding the organizational process or system by analyzing the obtained information about the organization;

the computer system identifying one or more assessors from the obtained potential assessor information

Support for the amendment is found in Applicant's specification, which states in part:

Assessment initiator system 210 may interact with an assessment initiator. The "assessment initiator" may be a person initiating the organizational process or system assessment. The initiator may be required to go through multiple security methods to ensure security in user access and privacy of information. Security methods may include, but are not limited to use of certificates, cookies, secure socket layers, virtual private networks, firewalls, etc. For example, the assessment initiator may be a company president or senior officer. Assessment initiator system 210 may, for example, identify personnel to act as assessors for the information gathering system 212. Assessment initiator system 210 may also identify subject matter to be assessed. Assessment initiator system 210 may also gather general organizational characteristics.

(Specification, page 7, lines 6-17).

Upon entry of such information by the human assessor, the assessment initiator system suitably generates at least one question configured to identify personnel with substantive knowledge of specific subjects pertinent to the assessment (step 314). Such personnel may include, for example, high-ranking employees, supervisors, board members, officers or the like. For example, a first question may request the name and office location of the director of purchasing, and a second question may ask for similar information for the director of human resources. Any number of questions may be posed to identify any number of persons or departments likely to possess relevant information. The nature of these questions may be adjusted according to previous information submitted by the human assessor. For example, if the human assessor previously indicated that the

organization has no computer system, questions for identifying the director of computer systems may be omitted. Similarly, if the human assessor indicated that the organization has a legal department, the assessment initiator system 210 may request further information, such as names and office locations for the general counsel, chief patent counsel, and chief litigation counsel

....Notification system 216 may then initiate information gathering system 212 by notifying appropriate individuals identified by assessment initiator system 210 that the individuals have been selected as assessors to gather specific information relating to the relevant organization within the assessment timeline. (Specification, page 9, line 19 through page 10, line 19).

Guinta does not teach or suggest the combination of the features of claim 71. Guinta states, “Typically the assessor has at least some knowledge about the organizational process or system” (Guinta, column 5, lines 62-63). Guinta discloses that the assessor has some knowledge about an organizational process or system. Guinta does not appear to teach or suggest “obtaining information about the organization to be assessed, wherein the information comprises information regarding potential assessors, wherein obtaining the information regarding potential assessors comprises the computer system generating at least one question configured to identify at least one person with knowledge pertinent to an assessment; the computer system preparing at least one question regarding the organizational process or system by analyzing the obtained information about the organization, and the computer system identifying one or more assessors from the obtained potential assessor information”, in combination with the other features of claim 71. As such, Applicant submits that claim 71 and the claims dependent thereon are patentable over Guinta.

E. The Claims Are Not Obvious Over Guinta In View of Barton et al. Pursuant To 35 U.S.C. § 103(a)

Claims 1-24, 28-47, 49, 52-57, 61-64, 72, 73, 78-99, 102-112, 144, and 145 were rejected as being unpatentable over Guinta in view of U.S. Published Application No. 2002/0059093 to Barton et al. (hereinafter “Barton”). Applicant respectfully disagrees with these rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner et al.*, 379 F.2d 1011, 154 USPQ 173, 177-178 (C.C.P.A.

1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

Amended claim 1 includes a combination of features including:

prompting an assessor to select at least two standards against which to assess the organizational process or system, wherein at least one question is provided within a computer to assess each selected standard, wherein at least one of the two selected standards is a recognized industry standard prescribing system or process criteria and wherein the recognized industry standard is selected based on the general information about the organization process or system;

Support for the amendment is found in Applicant's specification, which states in part:

The organizational assessment system preferably includes a plurality of questions directed the requirements of recognized standards. Recognized standards may include national and international standards as well as industry specific standards. The standards may prescribe system or process criteria regarding quality, leadership, cost, delivery, customer satisfaction, manufacturing technology, tool development, and/or environmental, health and safety concerns. Such standards may include, but are not limited to: ISO 9000, AS 9000, QS 9000, ISO 14000, ASQC, Lean Manufacturing, Six Sigma, etc. The operational assessment system may also include questions directed to financial, and other business concerns, or other topics. For example, Table 1 contains a list of topics that may be presented. The assessment initiator system may request information concerning which standard (or standards) are to be used when evaluating an organizational process or system (step 311)...

(Specification, page 8, line 22 - page 9, line 8).

The Office Action states:

Barton et al disclose Question owner's matrix 100 lists compliance assessment areas 102, which are present to the assessor as selected standards on which the assessment is based, wherein the compliance assessment areas include equal employment opportunity, antitrust, and ethical business practices (P0062, figure 4). These types (i.e., equal employment opportunity, antitrust, and ethical business practices) of compliance assessment areas are indeed recognized standards."

Applicant respectfully disagrees with the Examiner's position. Barton states:

First, a cross-functional team is assembled 72 to determine what constitutes compliance.

(Barton, paragraph 0056)

Interviews 78 are conducted with process owners for area compliance program status. As used herein interviewing means receiving information. Interviewing includes receiving information via a questionnaire, which may be stored within server 12 as part of the knowledge base. As described above, the knowledge base is stored in a central database within server 12 and may include a questionnaire spreadsheet 80.

(Barton, paragraph 0059)

In one embodiment, interviews 78 (shown in FIG. 3) are conducted in accordance with a question owner's matrix. More specifically, FIG. 4 shows one embodiment of a question owner's matrix 100. A question owner's matrix 100 is used as a guideline for identifying an interviewee for each sub-group of questions. The question owner's matrix 100 is constructed using the knowledge base within server 12. The knowledge base may include any information relevant to conducting an interview relating to compliance. The knowledge base may include, for example, information associating a group of questions with relevant functional knowledge, a summary of the details of program current status, improvement opportunities, identification of action item owners and a list of potential best practices. The question owner's matrix 100 lists compliance assessment areas 102. Compliance assessment areas 102 are any areas of a business that are being reviewed for compliance. Examples of compliance assessment areas 102 include, but are not limited to infrastructure, equal employment opportunity, antitrust, trade controls, ethical business practices and supplier relationships. The question owner's matrix 100 may also identify potential interviewees 104 by function for each area assessment using the knowledge base. Examples of interviewees 104 include, but are not limited to engineering, marketing, manufacturing, legal, purchasing, finance, and human resources.

(Barton, paragraph 0062)

Barton appears to teach forming a team to determine what constitutes compliance. Barton also appears to teach conducting interviews to determine the compliance program status (78). The specific questions are determined based on a knowledge base, which is stored on a server 12. Applicant submits that “compliance assessment areas” disclosed in Barton do not appear to be recognized industry standards prescribing system or process criteria. Moreover, Barton does not appear to teach or suggest prompting an assessor to select at least two standards against which to assess the organizational process or system against which to assess the organizational process or system. Applicant respectfully submits that Guinta in combination with Barton does not appear to teach or suggest prompting an assessor to select at least two standards against which to assess the organizational process or system, wherein at least one question is provided within a computer

to assess each selected standard, wherein at least one of the selected standards is a recognized industry standard prescribing system or process criteria, and wherein the recognized industry standard is selected based on the general information about the organization process or system, in combination with the other features of the claim. As such, Applicant submits that claim 1 and the claims dependent thereon are patentable over the cited art.

For at least the reasons stated above, Applicant submits that claims 40, 53, 144, and the claims dependent thereon are patentable over the cited art.

Applicant submits that many of claims dependent on claims 1, 40, 53, and 144 are independently patentable. For example, claim 30 recites: “prompting an assessor to provide recommendations to improve the organizational process or system.” Claim 31 recites: “prompting an assessor to provide recommendations to improve the organizational process or system by use of an user adjustable icon system, wherein selecting a value on a first user adjustable icon limits the range of values displayed for selection on a second user adjustable icon.” The cited art does not appear to teach or suggest at least these features of claims 30 or 31, in combination with the other features of the claims.

Guinta states:

On-site evaluation teams might then be directed to focus their efforts on investigating the 8 issues that were below 45% instead of all 100 issues, thereby saving manpower and expense.

(Borghesi, column 9, lines 18-29)

Guinta discloses on-site evaluation teams being directed to focus efforts on issues that are below a certain value, rather than all the issues. Guinta also discloses a sliding bar scale in FIG. 5E. Guinta does not appear to teach or suggest prompting an assessor to provide recommendations to improve the organizational process or system. Guinta further does not appear to teach or suggest wherein selecting a value on a first user adjustable icon limits the range of values displayed for selection on a second user adjustable icon. Applicant respectfully submits that claims 30 and 31 are allowable over the cited art.

F. **The Claims Are Not Obvious Over Guinta In View of Barton et al. And In Further View of Mann Pursuant To 35 U.S.C. § 103(a)**

Claims 25-27, 48, 50, 51, 58-60, 74-77, 100, 101, and 135-137 were rejected as being unpatentable over Guinta in view of Barton et al. and in further view of U.S. Published Application No. 2002/0019765 to Mann et al. (hereinafter “Mann”). Applicant respectfully disagrees with these rejections.

Claim 27 states in part, “escalating a notification to one or more predetermined individuals if a response is not received from an assessor within a predetermined period of time.”

Claim 75 states in part, “sending at least one reminder notification if answers are not received within a predetermined period of time.”

Claim 76 states in part, “sending the at least one prepared question to a different assessor if answers are not received within a predetermined period of time.”

Claim 77 states in part, “sending at least one reminder notification to an assessor’s supervisor if answers are not received within a predetermined period of time.”

Mann states,

Referring now to FIG. 10, there is shown a screenshot of a completion data form 1000 according to an exemplary embodiment in which the overall status of evaluations throughout the organization can be monitored. In particular, completion data form 1000 allows an administrator to track the status of each phase of all the evaluations being conducted in the organization. In an exemplary embodiment, completion data form 1000 displays a manager nomination status line 1001 indicating the employees that have nominated a manager as an evaluator. A completed column 1009 and a percent (%) completed column 1010 indicates the number and percent of employees that have nominated managers as evaluators, respectively. Completion data form 1000 also displays a manager confirmation status 1002 line that indicates the number and percentage of manager's that confirmed their nomination as evaluators. An evaluator nomination

status line 1003 is included that indicates the number and percent of employees that have nominated others, such as peers and direct reports, as evaluators. A self-evaluation status line 1004 is included that indicates the number and percentage of evaluatees that have completed their self-evaluation. A manager evaluation status line 1005 is included that indicates the number and percentage of managers that have completed their assigned manager evaluations. A feedback status line 1006 is included that indicates the number and percentage of evaluations that have been sent to evaluatees for the evaluatees comments. A feedback link status (evaluates) line 1007 and a feedback link status (manager) line 1008 are included that indicates the number and percentage of evaluations that have been signed off by evaluatees and managers, respectively. In addition, any other information regarding the status of the evaluation process may be displayed by completion data form 1000.

In an exemplary embodiment, upon activating each of status lines 1001-1008, such as by clicking on it with a computer mouse, a list of the information summarized by the particular one of status lines 1001-1008 is displayed. For example, by activating manager nomination status line 1001, a list of the employees that have nominated managers as evaluators is displayed. Accordingly, completion data form 1000 provides the administrator with a snapshot of the evaluation process throughput the organization as well as the ability to examine any aspect of the process in greater detail.

(Mann, page 5, paragraphs 0063 and 0064).

Mann appears to teach tracking a status of an evaluatee or evaluator completing an evaluation form based on the evaluatee starting the evaluation. The information provided by Mann therefore relates to determining if an evaluation is completed. Mann does not appear to teach or suggest escalating a notification to one or more predetermined individuals if a response is not received from an assessor within a predetermined period of time. Mann does not appear to teach or suggest sending at least one reminder notification if answers are not received within a predetermined period of time. Mann does not appear to teach or suggest sending the at least one prepared question to a different assessor if answers are not received within a predetermined period of time. Mann does not appear to teach or suggest sending at least one reminder notification to an assessor's supervisor if answers are not received within a predetermined period of time. Applicant submits that claims 27, 75, 76, and 77 are patentable over Guinta in view of Barton and in further view of Mann.

For at least the reasons stated above, Applicant submits claims 51 and 60 are patentable over Guinta in view of Barton and in further view of Mann.

G. Guinta '101 Is Not Prior Art for the Present Application

Claims 67, 68, 115-117, 123-134 and 138-143 were rejected as being unpatentable over Guinta (U.S. Patent No. 5,737,494 to Guinta et al.) in view of U.S. Patent No. 6,161,101 to Guinta et al. (hereinafter “Guinta ‘101”). Applicant respectfully disagrees with these rejections.

Applicant respectfully submits that Guinta ‘101 is not prior art with respect to the present application. Specifically, Guinta ‘101 is not prior art under Section 102(b) because Guinta ‘101 issued less than one year before Applicant filed the present application. Guinta ‘101 also does not appear to be prior art under Sections 102(a) and 102(e) because the inventors in the Guinta ‘101 application are identical to the inventors in the present application. Disclosure to the public of one's own work constitutes a bar to the grant of a patent claiming the subject matter so disclosed (or subject matter obvious therefrom) only when the disclosure occurred more than one year prior to the date of the application. *In re Katz* 687 F.2d 450, 454 (Cust. & Pat.App. 1982). In *In re Katz*, the Court of Customs and Patent Appeals stated:

It may not be readily apparent from the statutory language that a printed publication cannot stand as a reference under s 102(a) unless it is describing the work of another. A literal reading might appear to make a prior patent or printed publication “prior art” even though the disclosure is that of the applicant's own work. However, such an interpretation of this section of the statute would negate the one year period afforded under s 102(b) during which an inventor is allowed to perfect, develop and apply for a patent on his invention and publish descriptions of it if he wishes. *Illinois Tool v. Solo Cup Co.*, 461 F.2d 265, 172 USPQ 385 (CA 7), cert. denied, 407 U.S. 916, 92 S.Ct. 2441, 32 L.Ed.2d 691 (1972).

Thus, one's own work is not prior art under s 102(a) even though it has been disclosed to the public in a manner or form which otherwise would fall under s 102(a). Disclosure to the public of one's own work constitutes a bar to the grant of a patent claiming the subject matter so disclosed (or subject matter obvious therefrom) only when the disclosure occurred more than one year prior to the date of the application, that is, when the disclosure creates a one-year time bar, frequently termed a “statutory bar,” to the application under s 102(b). As stated by this court in *In re Facius*, 56 CCPA 1348, 1358, 408 F.2d 1396, 1406, 161 USPQ 294, 302 (1969), “But certainly one's own invention, whatever the form of disclosure to the public, may not be prior art against oneself, absent a statutory bar.”

In re Katz 687 F.2d 450, 454 (Cust. & Pat.App. 1982) (Emphasis added)

See also Invitrogen Corp. v. Biocrest Mfg., L.P. 424 F.3d 1374, 1381 (Fed. Cir. 2005) (“[A]n inventor's own work cannot be used to invalidate patents protecting his own later inventive activities unless, *inter alia*, he places it on sale or uses it publicly more than a year before filing.” (citations omitted)); *see also* MPEP 2132(III).

Because Guinta ‘101 is not prior art with respect to the present application, Applicant respectfully requests removal of the rejections of claims 67, 68, 115-117, 123-134 and 138-143.

H. Additional Remarks

Based on the above, Applicant respectfully requests favorable reconsideration.

Applicant requests a three month extension of time is necessary. Applicant has enclosed a Fee Authorization to cover the fee the extension of time. If any additional fees are inadvertently omitted or if any fees are required, please charge those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5078-02500/EBM.

Respectfully submitted,

Eric B. Meyertons
Reg. No. 34,876

Attorney for Applicant

MEYERTONS, HOOD, KIVLIN, KOWERT, & GOETZEL, P.C.
P.O. Box 398
Austin, TX 78767-0398
(512) 853-8800 (voice)
(512) 853-8801 (facsimile)

Date: December 12, 2006